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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/561,752 | 01/26/2006 | Anthony Bruce Pike | 16-978P/US | 1633 |
| 26294 | 7590 | 02/05/2008 | EXAMINER | |
| TAROLLI, SUNDHEIM, COVELL, & TUMMINO L.L.P. 1300 EAST NINTH STREET, SUITE 1700 CLEVELAND, OH 44114 | | | NICHOLSON, KERI JESSICA | |
| ART UNIT | | PAPER NUMBER | | |
| 4153 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 02/05/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/561,752 | Applicant(s) PIKE, ANTHONY BRUCE |
| | Examiner KERI J. NICHOLSON | Art Unit 4153 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on _____.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-22 is/are pending in the application.
 4a) Of the above claim(s) 3,10,11 and 13 is/are withdrawn from consideration.
 5) Claim(s) ____ is/are allowed.
 6) Claim(s) 1,2,4-9,12 and 14-22 is/are rejected.
 7) Claim(s) ____ is/are objected to.
 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1668)
 Paper No(s)/Mail Date 2006/04/10

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION***Abstract***

1. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

2. The abstract of the disclosure is objected to because it is not descriptive of what Applicant regards as new in the art to which the invention pertains. Correction is required. See MPEP § 608.01(b).

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification:

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in

upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

3. The specification is objected to as failing to provide headings for each section.

Correction is required.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claim 16 uses the term "slice" which is not defined anywhere in the specification.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 16 recites the limitation "slice" in parts e) and f). There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102 / 103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by, in the alternative, under 35 U.S.C. 103(a) as being obvious over Berge (U.S. Patent No. 4,051,565).

10. Regarding claim 1, Berge discloses the use of a relatively friction-free material for transporting patients such as a woven nylon material (column 3, lines 38-40). It is generally well known in the art that a relatively friction-free material will have a coefficient of static friction substantially the same as its coefficient of dynamic friction. Furthermore, Applicant has disclosed that commercially available nylons DuPont T743, T749, and 98Wext/4 have suitable properties for the intended use but Applicant has not altered the properties to produce any unexpected result (pages 2-3 of Specification). It

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would have been obvious to one having ordinary skill in the art as the time the invention was made to use a low-frictional material, such as nylon, for a medical sheeting device since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

11. Regarding claim 2, Berge discloses the material is relatively friction-free. It would have been obvious to one having ordinary skill in the art that a relatively friction-free material is substantially the same as a material having a coefficient of friction less than 0.4.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4-7, 12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berge as applied to claims 1 and 2 above in view of DeBenedictis et al. (U.S. Patent Publication No. 2006/0252322).

14. Regarding claims 4, 12, and 14, Berge discloses the invention substantially as claimed described above but fails to teach that the linear density of the material is between 1,000 and 40 decitex and is about 470 decitex. DeBenedictis discloses that the commercially available nylon yarn DuPont T743, which has also been disclosed by Applicant as a suitable material, has a linear density of 467 decitex (Table 2).

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15. Regarding claims 5 and 7, Berge fails to teach that the material has a linear density of 350 decitex and a weight of 180 g/m². As disclosed by Applicant, commercially available DuPont T749 has a linear density of 350 decitex and a weight of 180 g/m² (pages 2-3 of Specification).

16. Regarding claim 6, Berge fails to teach that the material has a weight between 200 and 50 g/m². DeBenedictis discloses that the weight of DuPont 743 is 183 g/m² (page 3, ¶ 43).

17. Regarding claim 15, Berge fails to teach that the material has a linear density of about 50 decitex. As disclosed by Applicant, commercially available DuPont 98Wext/4 has a linear density of 50 decitex.

18. Claims 8 and 9 are rejected under 35U.S.C. 103(a) as being unpatentable over Berge as applied to claim 1 above in view of Kuehnreich (U.S. Patent No. 5,176,624). Berge discloses the invention substantially as claimed described above. However, Berge fails to teach that the material could be formed as a boot with one or more layers or that the boot could be formed without a toe. Kuehnreich discloses a shoe bandage adapted to be worn over a foot bandage, foot injuries, or foot wounds. It would have been obvious to one having ordinary skill in the art to use a medical material as disclosed in Berge in the form of a boot as taught by Kuehnreich for the care of foot related injuries (Abstract). Kuehnreich also discloses that the boot can be formed with a cutout (23) for the toes (column 4, lines 40-42).

19. Claims 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuehnreich (U.S. Patent No. 5,176,624).

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20. Regarding claim 16, Kuehnreich discloses a shoe bandage adapted to be worn over a foot bandage, foot injuries, or foot wounds, comprising:

a housing (1) for enveloping a foot;

a first and second end located about the housing such that the first end is

enclosed forming a toe and a second end includes an opening for receiving a foot (Fig. 3);

an external seam securing the housing of the boot from the first end to the second end (Fig. 7);

a slice (4) extending from the opening at the second end to a midsection of the boot;

a plurality of straps (8, 9) encompassing the slice for the substantially closing and securing the slice about a foot.

However, Kuehnreich fails to teach that a collar surrounds the opening at the second end or that it is made from a low frictional material with a coefficient of static friction substantially the same as its coefficient of dynamic friction.

It would have been an obvious matter of design choice to one having ordinary skill in the art to make the boot taught by Kuehnreich with a collar around the opening at the ankle since Applicant has not disclosed there is an advantage to having a collar and it appears that the invention would perform equally well. Whether having a collar solves any particular problem or produces any unexpected result, the use of a collar is merely a matter of engineering design choice, and thus does not serve to patentably distinguish the claimed invention over the prior art. *In re Kuhle*, 526 f.2d.553, 188 USPQ7 (CCPA 1975). Applicant is also reminded that the argument toward the criticality of an element

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will generally be given little patentable weight. The basis for criticality should be clearly disclosed in the specification or by affidavit. *In re Cole*, 140 USPQ 230 (CCPA 1964).

Furthermore, it would have been obvious to one having ordinary skill in the art to make the boot taught by Kuehnreich comprised of a low frictional material such as a nylon material. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416

21. Regarding claim 17, Kuehnreich discloses that the boot can be formed with a cutout (23) for the toes (column 4, lines 40-42).

22. Regarding claims 18-20 and 22, linear density, coefficient of friction, and weight are inherent properties of a given material. Applicant has disclosed that commercially available nylons DuPont T743, T749, and 98Wext/4 have suitable properties for the intended use but Applicant has not altered the properties to produce any unexpected result (pages 2-3 of Specification).

23. Regarding claim 21, Kuehnreich fails to teach that the boot material is woven. It would have been obvious to one having ordinary skill in the art to comprise the boot of a woven material for the purpose of flexibility and resiliency.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KERI J. NICHOLSON whose telephone number is (571) 270-3821. The examiner can normally be reached on Monday - Thursday, 8am-5pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jackson, can be reached at (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call (800) 786-9199 (IN USA OR CANADA) or (571) 272-1000.

KJN
/Keri J Nicholson/
Examiner, Art Unit 4153
2008/01/28

/Gary Jackson/
Supervisory Patent Examiner
Art Unit 4153